

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Goodman et al.

Serial No. 08/971,172

Filed: November 14, 1997

For: *Robo: A Novel Family of  
Polypeptides and Nucleic Acids*

Group Art Unit: 1647

Examiner: Turner, S.

Attorney Docket No. B98-006-2

CERTIFICATE OF TRANSMISSION

I hereby certify that this corr is being transmitted by facsimile to the  
Comm for Patents at 703-872-9307 on December 11, 2002.

Signature

Richard Aron Osman

#41  
D.G.J  
12/31/02

PETITION TO RESCIND ANSWER

The Commissioner for Patents  
Washington, DC 20231

Dear Commissioner:

We petition the Commissioner to rescind the Examiner's Answer dated 10/1/01 in this application. A copy of this Petition is being appended to our Reply Brief in this application.

We submit that the Answer is part of an illegal discriminatory examination procedure established by Examiners Kunz and Turner, of which we have repeatedly complained, and the Answer is non-compliant with 35USC132(a) and 37CFR1.193(a)(2) because it introduces into the record and relies on new evidence, which Applicants have not had an opportunity to consider. The Examiner may not introduce into the record and rely on any new evidence in an Examiner's Answer. Furthermore, this new evidence may not be considered by the Board, as Applicant has been afforded no opportunity to address and rebut this new evidence.

This application was filed over five years ago. The Office issued a first Action on the merits on 3/5/99, and we responded on 5/18/99. The Office issued a second, final Action on 10/14/99, and we responded on 11/12/99. Examiner Turner then issued a third, non-final action on 1/21/00, and we responded on 2/7/00. She issued a fourth, non-final Action on 5/10/00, and we responded on 8/31/00. She then sent a sequence listing Notice on 12/11/00, and we responded

on 1/5/01. She sent a fifth, non-final Action on 3/27/01, and we responded on 7/13/01. She then sent a sixth, final Action on 10/10/01. It is from this final Action which we are now attempting to appeal.

Apparently realizing that her rejections lack substantiation, Examiner Turner remarkably seeks to introduce in her Answer, for the first time, new evidence to support her rejections. In particular, the Examiner relies on a newly introduced email string to support her allegation of a 2-14-97 publication date. Ironically, this new evidence in fact further undermines her position by alleging yet another creation date of 2-7-97. Furthermore, the Examiner pointedly fails to note this discrepancy in her Answer.

However, neither we nor the Board are able to consider the Examiner's newly proffered evidence at this time. If the Examiner wishes to rely on new evidence to support her rejection, she may not introduce it for the first time in her Answer. Applicants have had no opportunity to confront or rebut this new evidence, and the Board may not consider unvetted evidence.

The Commissioner is requested to rescind the Answer and respond to our pending Appeal Brief in a manner consistent with applicable rules and governing laws.

The Commissioner is hereby authorized to charge any fees or credit any overcharges relating to this communication to my Deposit Account No. 19-0750 (order B98-006-2).

Respectfully submitted,  
SCIENCE & TECHNOLOGY LAW GROUP



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cc. Esther Kepplinger